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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/809,141	03/25/2004	Adam J. Ahne	2003-0455.02	7388
21972 7590 01/31/2008 LEXMARK INTERNATIONAL, INC. INTELLECTUAL PROPERTY LAW DEPARTMENT 740 WEST NEW CIRCLE ROAD BLDG. 082-1 LEXINGTON, KY 40550-0999			EXAMINER THOMPSON, JAMES A	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

10/809,141

Applicant(s)

AHNE ET AL.

Examiner

James A. Thompson

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 March 2004 and 01 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9/1/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

2. **Claim 21 is rejected under 35 U.S.C. 102(a) as being anticipated by Dotsubo (US Patent 6,556,243 B1).**

Regarding claim 21: Dotsubo discloses providing a plurality of capture-to functions via a user interface; and receiving input from a user indicating a selection of at least one of the plurality of capture-to functions (figure 1(48-66); column 6, lines 41-56; and column 8, lines 52-62 of Dotsubo – *image to be captured can be set by the interface to be a regular photograph image, a title image [such as shown in figure 5a of Dotsubo], or a template image [such as shown in figure 6a of Dotsubo] and stored accordingly*); capturing a first image (column 3, lines 60-65 of Dotsubo); processing a combination of the first image's size, shape, or intensity, based upon the selection of the user, to produce a processed image (column 7, lines 4-14 and column 8, lines 55-58 of Dotsubo – *title and template images reduced in resolution, reducing the number of pixels and therefore the size, and low pass filtering performed on title images, thus affecting the shape and intensity*); and a display device (figure 1(34) of Dotsubo); and placing the processed image in a background layer of the second image (figure 5a; column 4, lines 52-60; and column 6, lines 48-56 of Dotsubo – *template image output as the background of a composite image [as shown in figure 5c of Dotsubo]*).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dotsubo (US Patent 6,556,243 B1) in view of Schinner (US Patent Application Publication 2004/0218206 A1).

Regarding claim 1: Dotsubo discloses an image capture and output device (figure 1 of Dotsubo) for creating a scanned image of an original image (column 3, lines 60 to column 4, line 6 of Dotsubo), the device comprising: a user interface (figure 1(48-66) of Dotsubo) configured to present a plurality of capture-to functions and to receive input from a user indicating a selection of at least one of the plurality of capture-to functions (column 6, lines 41-56 and column 8, lines 52-62 of Dotsubo – *image to be captured can be set by the interface to be a regular photograph image, a title image [such as shown in figure 5a of Dotsubo], or a template image [such as shown in figure 6a of Dotsubo] and stored accordingly*); an image capturer (figure 1(11-20) of Dotsubo) configured to capture a first image (column 3, lines 60-65 of Dotsubo), where the size, shape, or intensity of the first image, or a combination of the first image's size, shape, and intensity is based upon the selected capture-to function (column 7, lines 4-14 and column 8, lines 55-58 of Dotsubo – *title and template images reduced in resolution, reducing the number of pixels and therefore the size, and low pass filtering performed on title images, thus affecting the shape and intensity*); and a display device (figure 1(34) of Dotsubo) configured to display the first image as a background layer in a copy (figure 5a; column 4, lines 52-60; and column 6, lines 48-56 of Dotsubo – *template image output as the background of a composite image [as shown in figure 5c of Dotsubo]*).

Dotsubo discloses a print engine configured to print said first image.

Schinner discloses using a print engine as an imaging device (para. 34 of Schinner).

Dotsubo and Schinner are combinable because they are from the same field of endeavor, namely processing and outputting digital image data in a system that contains a plurality of inputs and a plurality of outputs. At the time of the invention, it would have been obvious to one of ordinary skill in the art to use a printer instead of (or in addition to) an LCD display to output the first image. The suggestion for doing so would have been that a printer produces a more permanent copy than an LCD display and is simply an alternate means of image output. Therefore, it would have been obvious to combine Schinner with Dotsubo to obtain the invention as specified in claim 1.

5. Claims 2-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dotsubo (US Patent 6,556,243 B1) in view of Schinner (US Patent Application Publication 2004/0218206 A1) and Mori (US Patent Application Publication 2002/0018233 A1).

Regarding claim 2: Dotsubo discloses that one of the plurality of capture-to functions is a capture-to background function (figure 5a; column 4, lines 52-60; and column 6, lines 48-56 of Dotsubo – *template image is the background image and is originally captured*).

Dotsubo in view of Schinner does not disclose expressly that said function is a capture-to watermark function.

Mori discloses that a watermark image is printed as a background image (para. 42, lines 2-4 of Mori).

Dotsubo in view of Schinner is combinable with Mori because they are from the same field of endeavor, namely digital image data capture, processing, and composition. At the time of the invention, it would have been obvious to one of ordinary skill in the art to specifically use a watermark for the background, as taught by Mori. Thus, the capture-to function would be a capture-to watermark function. The suggestion for doing so would have been that the watermark is simply another type of background image, and both Dotsubo and Mori teach selecting from a plurality of different images to create a composite image (figures 5a-5c and column 6, lines 48-56 of Dotsubo and para. 18 of Mori). Therefore, it would have been obvious to combine Mori with Dotsubo in view of Schinner to obtain the invention as specified in claim 2.

Further regarding claim 3: Mori discloses that the first (watermark) image is stored at a reduced intensity (para. 42, lines 2-4 of Mori – *printed as a pale, and thus reduced intensity, tone; by combination with Dotsubo in view of Schinner, first image would be stored rather than printed*).

Further regarding claim 4: Mori discloses that the first (watermark) image is stored at a user-determined reduced intensity (para. 42, lines 1-5 of Mori – *user chooses watermark for background, which is at a reduced intensity, rather than a stamp*).

Further regarding claim 5: Mori discloses that the first (watermark) image is stored at about 10% intensity (para. 42, lines 2-4 of Mori – *printed at a pale intensity, which could be considered to be "about 10% intensity"; by combination with Dotsubo in view of Schinner, first image would be stored rather than printed*).

Further regarding claim 6: Mori discloses that the first (watermark) image is printed as a background layer at a masked intensity (para. 42, lines 1-4 of Mori – *a pale tone is a "masked intensity"*).

6. **Claims 7-8 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dotsubo (US Patent 6,556,243 B1) in view of Schinner (US Patent Application Publication 2004/0218206 A1) and Wnek (US Patent 5,633,678).**

Regarding claim 7: Dotsubo in view of Schinner does not disclose expressly that one of the plurality of capture-to functions is a capture-to header/footer function.

Wnek discloses separately capturing and designating the header and footer of a document (column 8, lines 8-25 of Wnek – *data extracted based on determined page layout, including header and footer portions of document pages*).

Dotsubo in view of Schinner is combinable with Wnek because they are from the same field of endeavor, namely digital image data capture, processing, and composition. At the time of the invention, it would have been obvious to one of ordinary skill in the art to further include the capability to capture and extract the header and footer of a document image, as taught by Wnek. The suggestion for doing so would have been that both Dotsubo and Wnek teach ways of generating composite images from a variety of different images and image types. Including the functionality taught by Wnek would result in an improved and more versatile system. Therefore, it would have been obvious to combine Wnek with Dotsubo in view of Schinner to obtain the invention as specified in claim 7.

Further regarding claim 8: Wnek discloses that the capture-to header/footer function captures a top portion and a bottom portion of the original image (column 8, lines 21-24 of Wnek – *header and footer are captured from the page of the original document image; header and footer by definition are at the top portion and bottom portion of the image*).

Regarding claim 11: Dotsubo discloses that the first image is stored at about 100% intensity (column 7, lines 4-14 and column 8, lines 55-58 of Dotsubo – *Title images are low-pass filtered, others are not filtered. As is known in the art, low-pass filtering of images gets rid of fine details and noise, but does not greatly alter the overall intensity. Thus, title images and other images are all stored at about 100% intensity*).

7. Claims 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dotsubo (US Patent 6,556,243 B1) in view of Schinner (US Patent Application Publication 2004/0218206 A1), Wnek (US Patent 5,633,678), and Nihei (US Patent 7,098,924 B1).

Regarding claim 9: Dotsubo in view of Schinner and Wnek does not disclose expressly that the top and bottom portion captured measures about 1 inch.

Nihei discloses that the top and bottom portions (along with other portions) of an image can be positioned and enlarged or reduced (column 5, line 61 to column 6, line 2 of Nihei). Thus, for a regular image, the top and bottom portions measuring about one inch is one of the many possible sizes of adjustment that fall within the teachings of Nihei.

Dotsubo in view of Schinner and Wnek is combinable with Nihei because they are from the same field of endeavor, namely digital image data capture, processing, and composition. At the time of the invention, it would have been obvious to one of ordinary skill in the art to further include the capability to adjust the sizing of the top and bottom portions of the captured image, as taught by Nihei. The suggestion for doing so would have been that both Dotsubo and Nihei teach ways of generating composite images from a variety of different images and image types. Including the functionality taught by Nihei would result in an improved and more versatile system. Therefore, it would have been obvious to combine Nihei with Dotsubo in view of Schinner and Wnek to obtain the invention as specified in claim 9.

Regarding claim 10: Dotsubo in view of Schinner and Wnek does not disclose expressly that the size of the top and bottom portion captured are user determined.

Nihei discloses that the top and bottom portions (along with other portions) obtained (captured *as per* the combination of Dotsubo in view of Schinner and Nihei) is user determined (column 5, line 61 to column 6, line 2 of Nihei – *user determines enlargement/reduction of image and surrounding portion, and thus controls the size of the portion of the surrounding area captured*).

Dotsubo in view of Schinner and Wnek is combinable with Nihei because they are from the same field of endeavor, namely digital image data capture, processing, and composition. At the time of the invention, it would have been obvious to one of ordinary skill in the art to further include the capability to adjust the sizing of the top and bottom portions of the captured image, as taught by Nihei. The suggestion for doing so would have been that both Dotsubo and Nihei teach ways of generating composite images from a variety of different images and image types. Including the functionality taught by Nihei would result in an improved and more versatile system. Therefore, it would have been obvious to combine Nihei with Dotsubo in view of Schinner and Wnek to obtain the invention as specified in claim 10.

8. Claims 12-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dotsubo (US Patent 6,556,243 B1) in view of Schinner (US Patent Application Publication 2004/0218206 A1) and Nihei (US Patent 7,098,924 B1).

Regarding claim 12: Dotsubo in view of Schinner does not disclose expressly that one of the plurality of capture-to functions is a capture-to border/frame function.

Nihei discloses obtaining and storing a border/frame of an image (column 5, lines 43-47 and lines 61-65 of Nihei – *border/frame designed and stored for use in composite image*).

Dotsubo in view of Schinner is combinable with Nihei because they are from the same field of endeavor, namely digital image data capture, processing, and composition. At the time of the invention, it

would have been obvious to one of ordinary skill in the art to further include the capability to obtain and store a border/frame portion of an image, as taught by Nihei, wherein obtaining the image data occurs *via* scanning, as taught by Dotsubo. The suggestion for doing so would have been that both Dotsubo and Nihei teach ways of generating composite images from a variety of different images and image types. Including the functionality taught by Nihei would result in an improved and more versatile system. Therefore, it would have been obvious to combine Nihei with Dotsubo in view of Schinner to obtain the invention as specified in claim 12.

Further regarding claim 13: Nihei discloses that the scan to border/frame function captures (*Nihei obtains, combination of Dotsubo in view of Schinner and Nihei scans and captures, as set forth in the rejection of claim 12*) one of a group selected from top, bottom, left and right portions of the original image or a subset thereof (column 5, line 61 to column 6, line 2 of Nihei – *border adjusted for top, bottom, left and right portions, so at least one of top, bottom, left and right portions of border exists*).

Further regarding claim 14: Nihei discloses that the top, bottom, left and right portions of the border can be positioned and enlarged or reduced (column 5, line 61 to column 6, line 2 of Nihei). Thus, for a regular image, the top, bottom, left and right portions measuring about one inch is one of the many possible sizes of adjustment that fall within the teachings of Nihei.

Further regarding claim 15: Nihei discloses that the size of the portion obtained (captured *as per* the combination of Dotsubo in view of Schinner and Nihei) is user determined (column 5, line 61 to column 6, line 2 of Nihei – *user determines enlargement/reduction of image and border, and thus controls the size of the portion of the border captured*).

Regarding claim 16: Dotsubo discloses that the first image is stored at about 100% intensity (column 7, lines 4-14 and column 8, lines 55-58 of Dotsubo – *Title images are low-pass filtered, others are not filtered. As is known in the art, low-pass filtering of images gets rid of fine details and noise, but does not greatly alter the overall intensity. Thus, title images and other images are all stored at about 100% intensity*).

9. **Claims 17 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dotsubo (US Patent 6,556,243 B1) in view of Schinner (US Patent Application Publication 2004/0218206 A1) and Clary (US Patent 6,826,551 B1).**

Regarding claim 17: Dotsubo in view of Schinner does not disclose expressly that one of the plurality of capture-to functions is a capture-to fax coversheet function.

Clary discloses capturing image data to a fax coversheet (column 6, lines 3-8 and column 12, lines 12-17 of Clary – *handwriting image is captured based on preprinted form, and sent to a fax coversheet*).

Dotsubo in view of Schinner is combinable with Clary because they are from the same field of endeavor, namely the composition of images from multiple image data sources. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to include the capture-to fax coversheet functionality taught by Clary. The suggestion for doing so would have been that both Dotsubo and Clary teach ways of generating composite images from a variety of different images and image types. Including the functionality taught by Clary would result in an improved and more versatile system. Therefore, it would have been obvious to combine Clary with Dotsubo in view of Schinner to obtain the invention as specified in claim 17.

Regarding claim 20: Dotsubo discloses that the captured image is stored at about 100% intensity of the original image (column 7, lines 4-14 and column 8, lines 55-58 of Dotsubo – *Title images are low-pass filtered, others are not filtered. As is known in the art, low-pass filtering of images gets rid of fine details and noise, but does not greatly alter the overall intensity. Thus, the captured title images and other images are all stored at about 100% intensity*).

10. Claims 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dotsubo (US Patent 6,556,243 B1) in view of Schinner (US Patent Application Publication 2004/0218206 A1), Clary (US Patent 6,826,551 B1), and Nihei (US Patent 7,098,942 B1).

Regarding claim 18: Dotsubo in view of Schinner and Clary does not disclose expressly scanning an upper portion of an imaged item.

Nihei discloses scanning an upper portion of an imaged item (column 5, line 61 to column 6, line 2 of Nihei – *the top [upper] portion of the image is scanned, along with other parts of the image*).

Dotsubo in view of Schinner and Clary is combinable with Nihei because they are from the same field of endeavor, namely digital image data capture, processing, and composition. At the time of the invention, it would have been obvious to one of ordinary skill in the art to further include the capability to specifically scan the upper portion of the imaged item, as taught by Nihei. The suggestion for doing so would have been that both Dotsubo and Nihei teach ways of generating composite images from a variety of different images and image types. Including the functionality taught by Nihei would result in an improved and more versatile system. Therefore, it would have been obvious to combine Nihei with Dotsubo in view of Schinner and Clary to obtain the invention as specified in claim 18.

Further regarding claim 19: Nihei discloses that the size and relative positioning of the captured images can be adjusted by the user (column 5, line 61 to column 6, line 2 of Nihei). Thus, for a captured image, a user can select the upper portion to measure about 33% of a height of the imaged item.

11. Claims 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dotsubo (US Patent 6,556,243 B1) in view of Brost (US Patent Application Publication 2005/0174462 A1).

Regarding claim 22: Dotsubo does not disclose expressly that the step of capturing a first image further comprises storing an image that represents only a portion of an image being imaged.

Brost discloses storing an image that represents only a portion of an image being imaged (para. 50 of Brost – *a cropped image is stored, and thus only a portion of the image being imaged is stored*).

Dotsubo and Brost are combinable because they are from similar problem solving areas, namely how to efficiently process and store a variety of digital image data. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to crop the input image according to the needs and/or desires of the user. The motivation for doing so would have been easily and conveniently change the cropping prior to image capture, so as to allow for more versatility in image composition (para. 6 of Brost). Therefore, it would have been obvious to combine Brost with Dotsubo to obtain the invention as specified in claim 22.

Further regarding claim 23: Brost discloses the step of cropping (para. 50 of Brost).

12. Claims 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dotsubo (US Patent 6,556,243 B1) in view of Mori (US Patent Application Publication 2002/0018233 A1).

Regarding claim 24: Dotsubo discloses placing the first image as a background layer (figure 5a; column 4, lines 52-60; and column 6, lines 48-56 of Dotsubo – *template image is the background image and is originally captured*).

Dotsubo does not disclose expressly that said background layer is at a masked intensity.

Mori discloses that a watermark image is printed as a background image (para. 42, lines 2-4 of Mori).

Dotsubo and Mori are combinable because they are from the same field of endeavor, namely digital image data capture, processing, and composition. At the time of the invention, it would have been obvious to one of ordinary skill in the art to specifically use a watermark for the background, as taught by Mori, thus setting the background layer at a masked intensity. The suggestion for doing so would have been that the watermark is simply another type of background image, and both Dotsubo and Mori teach

selecting from a plurality of different images to create a composite image (figures 5a-5c and column 6, lines 48-56 of Dotsubo and para. 18 of Mori). Therefore, it would have been obvious to combine Mori with Dotsubo to obtain the invention as specified in claim 24.

Further regarding claim 25: Mori discloses that the masked intensity is about 10% of an original image (para. 42, lines 2-4 of Mori – *printed at a pale intensity, which could be considered to be an intensity of "about 10% of an original image"*).

Further regarding claim 26: Mori discloses that the masked intensity is user determined (para. 42, lines 1-5 of Mori – *user chooses watermark for background, which is at a reduced intensity, rather than a stamp*).

13. Claims 27-28 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dotsubo (US Patent 6,556,243 B1) in view of Wnek (US Patent 5,633,678).

Regarding claim 27: Dotsubo does not disclose expressly the step of capturing a first image further comprises storing an image that is configured as a header/footer.

Wnek discloses separately capturing and storing the header and footer of a document (column 8, lines 8-25 of Wnek – *data extracted based on determined page layout, including header and footer portions of document pages*).

Dotsubo and Wnek are combinable because they are from the same field of endeavor, namely digital image data capture, processing, and composition. At the time of the invention, it would have been obvious to one of ordinary skill in the art to further include the capability to capture and extract the header and footer of a document image, as taught by Wnek. The suggestion for doing so would have been that both Dotsubo and Wnek teach ways of generating composite images from a variety of different images and image types. Including the functionality taught by Wnek would result in an improved and more versatile system. Therefore, it would have been obvious to combine Wnek with Dotsubo to obtain the invention as specified in claim 27.

Further regarding claim 28: Wnek discloses scanning the top and bottom portion of an imaged item (column 8, lines 21-24 of Wnek – *header and footer are captured from the page of the original document image; header and footer by definition are at the top portion and bottom portion of the image*).

Regarding claim 31: Dotsubo discloses storing the first image at approximately 100% intensity (column 7, lines 4-14 and column 8, lines 55-58 of Dotsubo – *Title images are low-pass filtered, others are not filtered. As is known in the art, low-pass filtering of images gets rid of fine details and noise, but*

does not greatly alter the overall intensity. Thus, title images and other images are all stored at about 100% intensity).

14. Claims 29-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dotsubo (US Patent 6,556,243 B1) in view of Wnek (US Patent 5,633,678) and Nihei (US Patent 7,098,924 B1).

Regarding claim 29: Dotsubo in view of Wnek does not disclose expressly that the top and bottom portion captured measures about 1 inch.

Nihei discloses that the top and bottom portions (along with other portions) of an image can be positioned and enlarged or reduced (column 5, line 61 to column 6, line 2 of Nihei). Thus, for a regular image, the top and bottom portions measuring about one inch is one of the many possible sizes of adjustment that fall within the teachings of Nihei.

Dotsubo in view of Wnek is combinable with Nihei because they are from the same field of endeavor, namely digital image data capture, processing, and composition. At the time of the invention, it would have been obvious to one of ordinary skill in the art to further include the capability to adjust the sizing of the top and bottom portions of the captured image, as taught by Nihei. The suggestion for doing so would have been that both Dotsubo and Nihei teach ways of generating composite images from a variety of different images and image types. Including the functionality taught by Nihei would result in an improved and more versatile system. Therefore, it would have been obvious to combine Nihei with Dotsubo in view of Wnek to obtain the invention as specified in claim 29.

Regarding claim 30: Dotsubo in view of Wnek does not disclose expressly that the size of the top and bottom portion captured are user determined.

Nihei discloses that the top and bottom portions (along with other portions) obtained (captured *as per* the combination of Dotsubo in view of Schinner and Nihei) is user determined (column 5, line 61 to column 6, line 2 of Nihei – *user determines enlargement/reduction of image and surrounding portion, and thus controls the size of the portion of the surrounding area captured*).

Dotsubo in view of Wnek is combinable with Nihei because they are from the same field of endeavor, namely digital image data capture, processing, and composition. At the time of the invention, it would have been obvious to one of ordinary skill in the art to further include the capability to adjust the sizing of the top and bottom portions of the captured image, as taught by Nihei. The suggestion for doing so would have been that both Dotsubo and Nihei teach ways of generating composite images from a variety of different images and image types. Including the functionality taught by Nihei would result in

an improved and more versatile system. Therefore, it would have been obvious to combine Nihei with Dotsubo in view of Wnek to obtain the invention as specified in claim 30.

15. Claims 32-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dotsubo (US Patent 6,556,243 B1) in view of Nihei (US Patent 7,098,924 B1).

Regarding claim 32: Dotsubo does not disclose expressly capturing an image of a border of an imaged item.

Nihei discloses obtaining an image of a border of an imaged item (column 5, lines 43-47 and lines 61-65 of Nihei – *border/frame designed and stored for use in composite image*).

Dotsubo and Nihei are combinable because they are from the same field of endeavor, namely digital image data capture, processing, and composition. At the time of the invention, it would have been obvious to one of ordinary skill in the art to further include the capability to obtain and store a border portion of an image, as taught by Nihei, wherein obtaining the image data occurs *via* scanning (and thus capturing), as taught by Dotsubo. The suggestion for doing so would have been that both Dotsubo and Nihei teach ways of generating composite images from a variety of different images and image types. Including the functionality taught by Nihei would result in an improved and more versatile system. Therefore, it would have been obvious to combine Nihei with Dotsubo to obtain the invention as specified in claim 32.

Further regarding claim 33: Nihei discloses scanning (*Nihei obtains, combination of Dotsubo in view of Schinner and Nihei scans and captures, as set forth in the rejection of claim 12*) the top, bottom, left and right portions of the imaged item (column 5, line 61 to column 6, line 2 of Nihei – *border adjusted for top, bottom, left and right portion, so said portions were obtained*).

Further regarding claim 34: Nihei discloses that the top, bottom, left and right portions of the border can be positioned and enlarged or reduced (column 5, line 61 to column 6, line 2 of Nihei). Thus, for a regular image, the top, bottom, left and right portions measuring about one inch is one of the many possible sizes of adjustment that fall within the teachings of Nihei.

Further regarding claim 35: Nihei discloses that the size of the portion obtained (captured *as per* the combination of Dotsubo in view of Schinner and Nihei) is user determined (column 5, line 61 to column 6, line 2 of Nihei – *user determines enlargement/reduction of image and border, and thus controls the size of the portion of the border captured*).

Regarding claim 36: Dotsubo discloses that the scanned image is stored at about 100% intensity of an original image (column 7, lines 4-14 and column 8, lines 55-58 of Dotsubo – *Title images are low-*

pass filtered, others are not filtered. As is known in the art, low-pass filtering of images gets rid of fine details and noise, but does not greatly alter the overall intensity. Thus, title images and other images are all stored at about 100% intensity).

Regarding claim 37: Dotsubo does not disclose expressly scanning an upper portion of an imaged item.

Nihei discloses scanning an upper portion of an imaged item (column 5, line 61 to column 6, line 2 of Nihei – *the top [upper] portion of the image is scanned, along with other parts of the image*).

Dotsubo and Nihei are combinable because they are from the same field of endeavor, namely digital image data capture, processing, and composition. At the time of the invention, it would have been obvious to one of ordinary skill in the art to further include the capability to specifically scan the upper portion of the imaged item, as taught by Nihei. The suggestion for doing so would have been that both Dotsubo and Nihei teach ways of generating composite images from a variety of different images and image types. Including the functionality taught by Nihei would result in an improved and more versatile system. Therefore, it would have been obvious to combine Nihei with Dotsubo to obtain the invention as specified in claim 37.

Further regarding claim 38: Nihei discloses that the size and relative positioning of the captured images can be adjusted by the user (column 5, line 61 to column 6, line 2 of Nihei). Thus, for a captured image, a user can select the upper portion to measure about 33% of a height of the imaged item.

Regarding claim 39: Dotsubo discloses storing the first image at about 100% intensity (column 7, lines 4-14 and column 8, lines 55-58 of Dotsubo – *Title images are low-pass filtered, others are not filtered. As is known in the art, low-pass filtering of images gets rid of fine details and noise, but does not greatly alter the overall intensity. Thus, title images and other images are all stored at about 100% intensity*).

Further regarding claim 40: Nihei discloses processing the images of a composite image to adjust their size or shape (column 5, line 61 to column 6, line 2 of Nihei). By combination with Dotsubo, this would include the second image.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James A. Thompson whose telephone number is 571-272-7441. The examiner can normally be reached on 8:30AM-5:00PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on 571-272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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/James A. Thompson/

James A. Thompson
Examiner
Technology Division 2625

24 January 2008